



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte NORIHISA FUKUTOMI, MASAYUKI AOTA, & OSAMU MATSUMOTO

Application 09/413,348

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on June 21, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On January 2, 2004, appellants filed a Notice of Appeal. On March 2, 2004, appellants filed an amendment and an Appeal Brief. On May 17, 2004, the Examiner mailed an Advisory Action denying entry of the amendment filed March 2, 2004. On May 18, 2004, the examiner mailed a Notification of Non-Compliance with 37 CFR 1.192(c), stating that the appendix of claims was defective, for it included the changes that were denied entry by the Advisory Action mailed May 17, 2004. On June 3, 2004, appellants filed an Information Disclosure Statement

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(IDS), a second after final amendment, and a Supplemental Appellants' Brief on Appeal Under 37 C.F.R. §1.192. On June 17, 2004, the examiner mails a second Notification of Non-Compliance with 37 CFR 1.192(c), for the arguments in the Supplemental Brief still included changes that were denied entry by the Advisory Action mailed May 17, 2004. On June 18, 2004, appellants filed a Second Supplemental Appellants' Brief on Appeal Under 37 C.F.R. §1.192. On July 27, 2004, the examiner mailed both a communication indicated that the IDS filed June 3, 2004 was considered, and the Examiner's Answer. On September 27, 2004, appellants filed their Reply Brief. The examiner on October 26, 2004 mailed a communication to appellants, indicating that the Reply Brief was considered. However, it is noted that there is no indication that the second after final amendment, filed June 3, 2004 was considered by the examiner. Appropriate correction is required.

If the amendment filed June 3, 2004 is denied entry, the Examiner must hold the Second Supplemental Appellants' Brief on Appeal Under 37 C.F.R. §1.192 defective, for it includes the changes made in the proposed amendment.

Accordingly, it is

ORDERED that the application is returned to the Examiner for:

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- 1) consideration of the amendment filed June 3, 2004;
- 2) provide written correspondence setting forth said consideration;
  - a) if the amendment is denied entry, the examiner needs to hold the Second Supplemental Appellants' Brief on Appeal Under 37 C.F.R. §1.192 filed June 18, 2004, defective;
  - b) no further action would be needed if the amendment is entered; and
- 3) for such further action as may be appropriate.

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